

In re Application of: Shen-Chen Kuo
Serial No.: 10/050,768
Filed: JANUARY 16, 2002

REMARKS

This amendment is in response to the Office Action mailed May 5, 2004. A response to the Office Action was due on August 5, 2004. Therefore, this response, filed with a one-month extension of time filed on or prior to September 5, 2004, is to be considered timely filed.

Please make of record the following comments and amendments.

Claims 1-10 and 13-24 are pending in the application. Claims 10 and 13-24 are allowed. Claims 1-8 are rejected. Claim 9 is objected to. Claims 1, 5 and 6 have been amended. New claim 29 has been added. Claims 3 and 4 have been canceled. No new matter has been added with the filing of this response.

Applicant thanks the Examiner for consideration of applicant's previous amendment and obviation of the § 112, second paragraph rejections and those prior art rejections in view of Wang and Chabala.

Claim Rejections - 35 USC § 112, First Paragraph

Claims 1-8 remain rejected by the Examiner under § 112, First Paragraph. The Examiner believes that the specification, while being enabled for $\text{Bu}_4\text{NI}/\text{H}_5\text{IO}_6$ as an oxidizing/cyclizing agent, does not reasonably provide enablement for any or all oxidizing/cyclizing agents generically.

In response, applicant respectfully traverses the above rejection and presents the following comments. Applicants have amended claim 1 to those oxidizing/cyclizing agents described in cancelled claim 3 and page 8, lines 5 to 17 of the specification. As stated in the response to the previous office action, the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosure in the patent coupled with information known in the art **without undue experimentation**. See generally, In re Wands,

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858 F.2d 731, 737, 8 USPQ.2d 1400, 1404 (Fed. Cir. 1998), *Ex Parte Foreman*
230 USPQ 546 (Bd. Of App. and Inter. 1986). *Spectra-Physics Inc. v.*
Coherent Inc., 827 F.2d 1524, 3 USPQ.2d 1737 (Fed. Cir. 1987), *In re*
Buchner, 929, F.2d 660, 661, 18 U.S.P.Q.2d 1331, 1332 (Fed. Cir. 1991) and
In re Gay, 309 F.2d 769, 774, 135 USPQ 311, 316 (C.C.P.A. 1962).

In the instant case and as acknowledged by the Examiner, applicant has provided working examples oxidation/cyclization reagents, which selectively oxidize the desired amino groups. Applicant has amended claim 1 by defining the group of oxidation/cyclization reagents from those listed in cancelled claim 3 and page 8 of the specification. Applicant respectfully suggests that amended claim 1 now provides the necessary guidance so as to enable one of ordinary skill in the art to practice the claimed invention, thus satisfying § 112 first paragraph. As required by case law and the MPEP, one of ordinary skill in the art can practice the claimed invention without undue experimentation.

As previously pointed out, applicant respectfully maintains that given the guidance supplied by applicant's specification and given the fact that the applicants are not required to bring to light every known example of oxidation/cyclization reagents in the applicant's specification, applicant believes that the amended claim 1 and dependent claims 2 and 5-8, enable one ordinary of skill in the art to practice the invention with regard to choosing a suitable oxidation/cyclization agent.

Claims 1-8 remain rejected by the Examiner under § 112, First Paragraph because the Examiner believes that the specification, while being enabled for Bu_4NI as a soluble iodide, does not reasonably provide enablement for any or all iodides generically.

In response, applicant respectfully traverses the above rejection and presents the following comments. As argued in the previous response to the Examiner's office action, applicant respectfully suggests that the disclosure of Bu_4NI as a working example, and the listing of numerous iodide reagents in cancelled claim 4 and on page 8 of the specification, satisfy the enablement

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requirement by providing a more than adequate road map to enable one of ordinary skill in the art to practice the invention without undue experimentation. (See above cited case law and requirements of the MPEP). Applicant respectfully suggests that they have sufficiently defined the scope of the iodide reagents to let this case proceed to allowance based on those described in cancelled claim 4. Applicant respectfully suggests that it would be mere routine experimentation to one of ordinary skill in the art to practice the invention with those iodide reagents described in amended claim 1 to serve as guidance.

The applicant has provided examples of oxidation/cyclization reagents and iodide groups, as required by the cited case law above. Therefore, applicant respectfully states that the specification and claims 1, 2 and 5-8 meet the statutory requirements of 35 U.S.C. Section 112, first paragraph. Armed with this knowledge, one skilled in the art would be able to use the claimed process without undue experimentation. Therefore, Applicant respectfully requests the withdrawal of this rejection.

Accordingly, in light of these comments, applicant respectfully requests the withdrawal of this rejection.

Allowability of Claim 9

Claim 9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. §112, 2nd paragraph to include all of the limitations of base claim and any intervening claims. In response, applicant has added new claim 29, which is essentially claim 9. Further, applicant respectfully suggests that with the amendment of claim 1, pending claim 9 is now in condition for allowance.

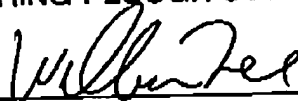
No fees, other than the fee for the one-month extension of time, are believed to be due with this amendment. If any fees are determined to be due by this paper, the Commissioner is hereby authorized to deduct such fees from Account No. 19-0365.

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If for any reason the Examiner believes that an interview would be helpful to resolve any remaining issues, he is invited to telephone the undersigned at the number listed below.

Respectfully submitted,

SCHERING-PLOUGH CORPORATION



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